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8439	7590	03/01/2007	EXAMINER	
ROBERT E. BUSHNELL			KLIMOWICZ, WILLIAM JOSEPH	
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WASHINGTON, DC 20005-1202				
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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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09. 892.790

EXAMINER

ART UNIT	PAPER
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20070226

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

See enclosed Attachments.

Commissioner for Patents

William J. Klimowicz
Primary Examiner
Art Unit: 2627

***Examiner's Response to Clarification Request of Board of Patent Appeals
and Interferences***

This communication is in response to a request from the Board of Patent Appeals and Interferences, hereinafter referred to as the Board, mailed February 12, 2007. The Board requested further clarification as to how the Examiner was reading the reference Nepela (US Patent No. 5,569,981) on claims 21, 30-32 and 41 as rejected in the pending Appeal. More specifically, the Board stated:

We would appreciate further input from the Examiner on precisely how the Examiner sees the claims on appeal to be anticipated. Most respectfully, we ask the Examiner to reproduce each of the claims on appeal and after each claim limitation insert a reference to the drawing element and specification (by column and lines) so that we can better appreciate how the Examiner believes that all the limitations of the claims are described by Nepela.

See page 3 of the Board's request.

Therefore, as per the Board's request, the Examiner has clarified the rejection as set forth, *infra*.

After careful consideration of all the facts, including the arguments presented by the Appellant and the original Examiner of the Examiner's Answer, the current Examiner has concurred with the original Examiner and the conferees of Art Unit 2627, that claims 21, 30-32 and 41 not only reasonably read on Nepela et al. (US 5,568,981), but do so in a manner that is completely within the context of Appellant's disclosure, and moreover, in the opinion of this

Examiner, clearly and unquestionably exceeds the requisite preponderance of the evidence to maintain the rejection of record.

Pertaining to the claims rejected under 35 U.S.C. § 102 as being anticipated by the disclosure of Nepela et al. (US 5,568,981) the following should be noted. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); *cert. dismissed*, 468 U.S. 1228 (1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The current Examiner of this application, as clearly articulated in the rejection, *infra*, has set forth a one-to-one correspondence with each and every element of the *claimed* invention, as rejected by the previous Examiner (and the previous Examiner's consultation with the conferees of the Appeal Conference held February 21, 2003). More concretely, as recited MPEP§2106:

Office personnel are to give claims their ***broadest reasonable interpretation*** in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). ***Limitations appearing in the specification but not recited in the claim are not read into the claim.*** *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. . . . An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."). [Emphasis in bold italics added].

Moreover, one must also bear in mind that limitations contained within Appellant's arguments cannot be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 386 F.2d 924, 155 USPQ 687 (CCPA 1968).

As set forth in the MPEP§ 706, "the standard to be applied in all cases is the 'preponderance of the evidence' test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable." Clearly, the Examiner has established that one of ordinary skill in the art would reasonably construe the one-to-one correspondence with each and every element of the *claimed* invention, in the manner set forth in the rejection, *supra*, by at least the *preponderance* of the evidence. In view of the original Examiner, the conferees, and the Examiner of this clarification communication, the Appellant's arguments have fallen well short of rebutting the Examiner's *prima facie* case of anticipation.

Claim Rejections - 35 USC § 102

The following is a clarified restatement of a rejection previously made under 35 USC section 102.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21, 30, 31, 32 and 41 were previously rejected under 35 U.S.C. 102(a) as being anticipated (clearly anticipated by those having experience within the art) by Nepela et al. (US 5,568,981). As also noted by the Board, Nepela et al. (US 5,568,981) is also prior art under 35 U.S.C. 102(e). See page 2 of Board's request, mailed February 12, 2007

To facilitate the rejection, please also see the appended marked-up copy of Nepela (US 5,568,981). As per claim 21, Nepela et al. (US 5,568,981) discloses a negative pressure air bearing slider having a negative pressure cavity (e.g., see in particular surface area recessed from platform (108) rail and also located aft of rail (108) - see also COL. 2, ll. 44-51), comprising: a body (i.e., the slider body depicted in, e.g., FIG. 5c, *in toto*) with a principal surface (i.e., the surface excluding the platform rails, indicated in diagonal cross-hatch, e.g., in Fig. 5c) disposed to confront a recording surface of a recording medium, said principal surface having a lead portion (e.g., a portion, or any portion for that matter, of the slider body that is disposed toward the conventional leading edge of the slider) and a rear portion, (e.g., a portion or any portion for that matter, of the slider body that is disposed toward the conventional rear edge of the slider and downstream of the aforementioned lead portion) said lead portion being spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider, said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body; and a U-shaped air bearing platform (108) defining a negative pressure cavity (cavity which includes the space between the rails of the U-shaped air bearing platform which indeed provides "a central recessed cavity that extends from the central pad to the trailing edge of the slider" - e.g., see COL. 2, ll. 50-51) on said principal surface, said U-

shaped air bearing platform (108) comprising not more than two separate air bearing platforms (e.g., the left side leg of the U-shaped air bearing as seen in FIG. 5c and the right side leg of the U-shaped air bearing as seen in FIG. 5c - the platforms joined by a cross-rail extending normal to the longitudinal direction of the slider), said platforms each extending rearwardly toward said rear portion of said principal surface and respectively terminating at a first rear termination and a second rear termination (see Examiner's marked-up copy of FIG. 5c, appended herewith), at least one of said not more than two separate air bearing platforms including a side wall portion (e.g., vertical wall surface extending from the air-bearing surface of the air bearing platform 1 or 2, to the bottom principal surface); at least one of said first rear termination and said second rear termination not coinciding with said rear edge (e.g., please note that the 1st and 2nd rear terminations do not extend to the rear edge - see Examiner's marked-up copy of FIG. 5c, appended herewith), and being disposed upstream of said rear edge relative to said rotational direction of said recording medium - again, please see Examiner's marked-up copy of FIG. 5c, appended herewith.

As per claim 30, further comprising: a rear air bearing platform (120) (e.g., see FIG. 5c) accommodating mounting of a transducer (e.g., see, *inter alia*, COL. 5, ll. 42-43), said rear air bearing platform (120) being spaced downstream of said U-shaped air bearing platform (108) relative to a rotational direction of said recording medium, and being centered with respect to a longitudinal axis of said slider body - please see in particular, COL. 7, ll. 39-41.

Additionally, as per claim 31, Nepela et al. (US 5,568,981) discloses a negative pressure air bearing slider (e.g., see in particular surface area recessed from platform (108) rail and also located aft of rail (108) - see also COL. 2, ll. 44-51); comprising: a principal surface defining a

first plane tangential to a first direction (e.g., the plane of the aforementioned principal surface excluding the platform rails, indicated in diagonal cross-hatch, e.g., in Fig. 5c, with the first [longitudinal] direction being indicated in the Examiner's marked-up copy of FIG. 5c, appended herewith); said principal surface having a lead portion (e.g., a portion or any portion for that matter, of the slider body that is disposed toward the conventional leading edge of the slider) and a rear portion (e.g., a portion or any portion for that matter, of the slider body that is disposed toward the conventional rear edge of the slider and downstream of the aforementioned lead portion), said lead portion being spaced upstream from said rear portion relative to said first direction (e.g., the longitudinal direction, with the initial airflow that impinges on tapers (22), from the leading edge of the slider, to the slider trailing edge), said lead portion having a front edge - again, please see Examiner's marked-up copy of FIG. 5c of Nepela (US 5,568,981) appended herewith), said rear portion having the aforementioned rear edge, said front edge and said rear edge together defining longitudinal boundaries of said principal surface in said first direction (as can be readily seen with reference to FIG. 5c); and said U-shaped air bearing platform (108) having a plurality of air bearing surfaces surrounding a negative pressure cavity (e.g., the recessed pocket located between the aforementioned air bearing platform 1 and air bearing platform 2) while defining a second plane tangential to said first direction (note that this "second plane" is a plane that is located within the plane of the raised air bearing platform above the principal surface, and along the first or longitudinal direction as seen in the marked-up copy of FIG. 5c of Nepela (US 5,568,981), said U-shaped air bearing platform comprising not more than two separate air bearing platforms (e.g., the left side leg of the U-shaped air bearing as seen in FIG. 5c and the right side leg of the U-shaped air bearing as seen in FIG. 5c - the platforms

joined by a cross-rail extending normal to the longitudinal direction of the slider), each platform extending from said lead portion rearwardly toward said rear portion and respectively terminating at the aforementioned and depicted in marked-up form, first rear termination and a second rear termination, at least one of said not more than two separate air bearing platforms including a side wall portion - see marked-up copy of FIG. 5c of Nepela (US 5,568,981); at least one of a surface (i.e., the principal surface of the diagonal cross-hatch behind the 1st and 2nd rear terminations) between said first rear termination and said rear edge and a surface between said second rear termination and said rear edge being in said first plane (e.g., the plane of the surface excluding the platform rails, indicated in diagonal cross-hatch, e.g., in Fig. 5c - please see Examiner's marked-up copy of Nepela (US 5,568,981) enclosed herewith).

As per claim 32, wherein said U-shaped air bearing platform further comprising: a cross rail portion extending generally laterally across said principal surface.

E.g., please note that the left side leg of the U-shaped air bearing as seen in FIG. 5c and the right side leg of the U-shaped air bearing as seen in FIG. 5c - are the platforms joined by a cross-rail extending normal to the longitudinal direction of the slider, which is completely consistent with the Examiner claim language interpretation with regard to another independent claim - claim 21 - and is also completely consistent within the context of the Appellant's drawings and specification.

Additionally still, as per claim 41, further comprising: a rear air bearing platform (i.e., 120) accommodating mounting of a transducer (e.g., see, *inter alia*, COL. 5, ll. 42-43), said rear air bearing platform being spaced downstream of said U-shaped air bearing platform (108) - the U-shaped platform being defined by the aforementioned cross-rail and the air bearing platforms

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1 and 2) including relative to said first direction (i.e., the longitudinal or rotational direction of a disk relative to the slider; such rotational causing airflow to impinge first upon the lead edge with the leading edge tapers (22), and then exit the slider boy at the rear edge), and being centered with respect to a longitudinal axis of said slider body please see in particular, COL. 7, ll. 39-41.

Conclusion

The application is being re-forwarded to the Board of Patent Appeals and Interferences for a decision as it relates to the Brief's and Examiner's Answer previously submitted. As of the mailing date of this communication, jurisdiction of this application reverts to the Board of Patent Appeals and Interferences and any questions pertaining to the status and/or general matters related to this application should be directed thereto.

As noted by the Board (see page 5 of the Board's request, mailed February 12, 2007), the Appellant is reminded of the following:

ORDERED that the appeal is remanded to the Examiner for action not inconsistent with views expressed in this opinion.

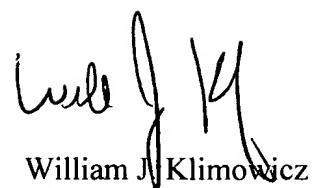
FURTHER ORDERED that except as otherwise expressly provided herein, the Board retains jurisdiction over the appeal.

FURTHER ORDERED that within **one (1) month** of the date the Examiner enters a response to this remand, Appellants may file a paper (not to exceed 10 pages) addressing the Examiner's response.

FURTHER ORDERED that oral argument scheduled for 21 February 2007 is cancelled and will be reset in due course.

FURTHER ORDERED that, unless otherwise ordered, the provisions of 37 C.F.R. § 1.136(a) (2006) are not applicable to further proceedings involving the application on appeal.

Art Unit: 2627



William J. Klimowicz
Primary Examiner
Art Unit 2627

WJK
February 26, 2007

Enclosed: Attachment A

Examiner marked-up copy of Fig. 5c
of Nepela (US 5,568,981)

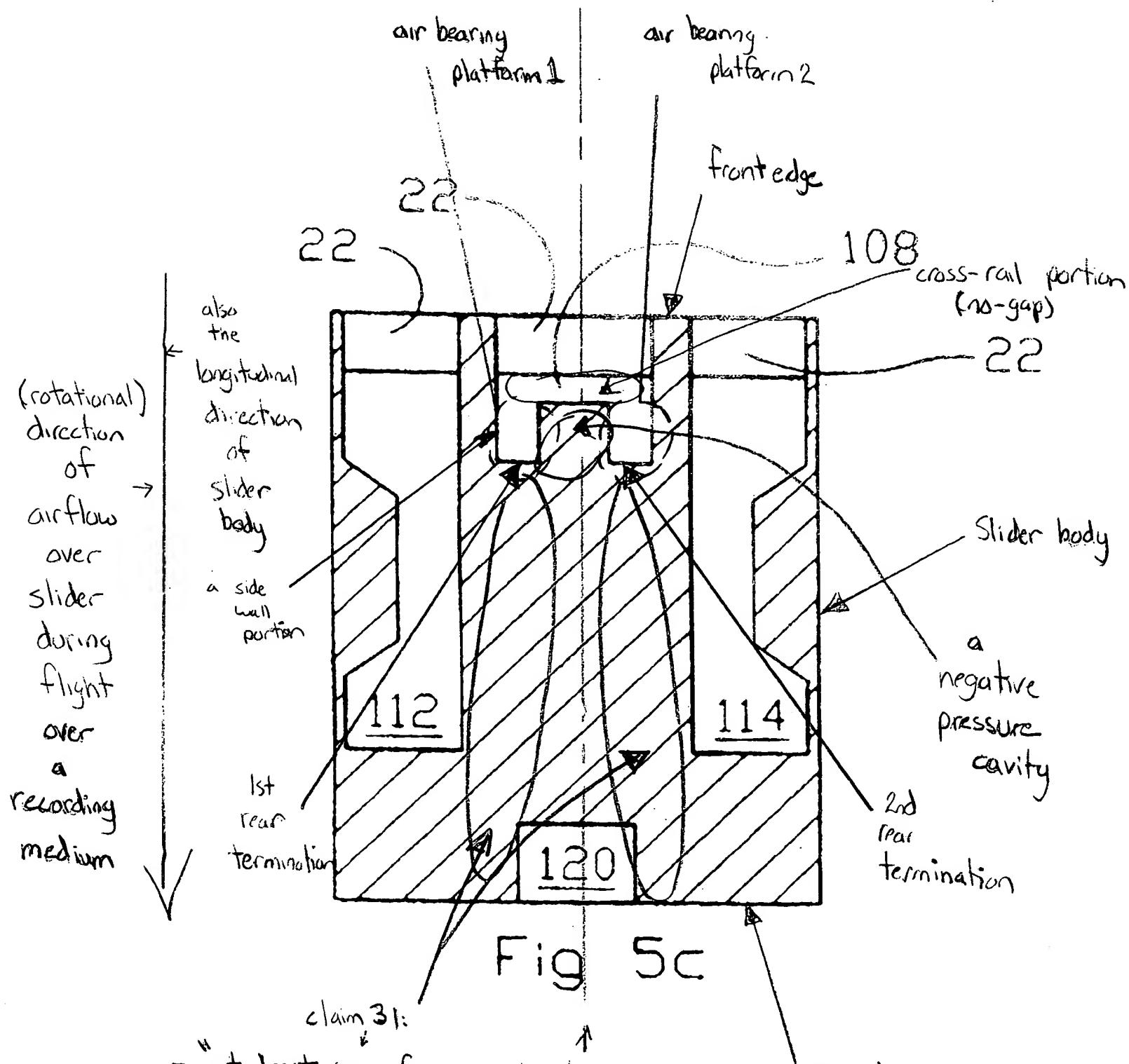


Fig 5c

claim 31:
- "at least one of
a surface between said
first rear termination and
said rear edge and a surface
between said second rear termination
and said rear edge → being in
said 1st (cross-hatched) plane"

↑
longitudinal
axis
of
slider

Wile J. Kly
WILLIAM KLIMOWICZ
PRIMARY EXAMINER

[Attachment A]